

Remarks

Rejections under 35 USC § 103

The claims of the present application have been rejected as being obvious based on van Hoorn in view of Nielsen either as a combination or as a combination with the addition of either Erilli or Fuestel. Applicant respectfully asserts the claims as set forth herein overcome and are allowable over these rejections. Applicant respectfully requests favorable reconsideration and withdrawal of the obviousness rejections.

With regard to the rejections under 35 U.S.C. §103(a), it is respectfully submitted that Applicants' claims are patentable, as the Examiner has failed to establish a *prima facie* case of obviousness. According to Section 706.02 (j) of the MPEP the Examiner must meet three basic criteria to establish a *prima facie* case of obviousness:

- (1) first, there must be some reasonable suggestion or motivation in the prior art to modify the reference or to combine the reference teachings;
- (2) second, there must be reasonable expectation of success in obtaining the claimed invention based upon the references relied upon by the Examiner; and
- (3) third, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations.

MPEP Section 706.02(j) further requires that the teaching or suggestion to make the modification or reference combination and the expectation of success, must be found in the prior art, and may not be based upon the Applicants' disclosure.

van Hoorn provides a release composition in the form of an oil-in-water emulsion and comprising esters of polyhydric alcohols having an improved stability in basic conditions. The emulsions further include an amount of water of 5-95% by weight.

The van Hoorn reference does not disclose a process using a composition which is:

less than 0.2% by weight of water;

non-emulsified; and

includes a terpene derivative.

As noted, the European counterpart of Nielsen is discussed in the present application on page 1, lines 24-28.

It appears that the current rejections are based on hindsight reconstruction relying upon the present application to provide support. A person of ordinary skill in the art combining van Hoorn with Nielsen would not achieve the claimed process. There is no explanation accompanying the rejection why a person of ordinary skill in the art would have modified the process disclosed in van Hoorn to replace the emulsified composition with a non-emulsified composition. The composition disclosed in van Hoorn comprises mold-release compositions comprising esters of polyhydric alcohols that show an improved stability against hydrolysis (column 2, lines 34-60). There is no motivation or suggestion to use a non-emulsified composition in place of the emulsified composition.

The non-emulsified compositions of Nielsen are asserted by the Examiner to be substitutes for the emulsified compositions of van Hoorn. The non-emulsified compositions of Nielsen, however, require neither an aqueous phase nor surfactants and thus do not form the alkaline aqueous medium affecting the stability of esters of mono- and dihydric alcohols (see van Hoorn, column 2, lines 38-45).

The Nielsen reference discloses a composition comprising esters of mono- and dihydric alcohols and suggests non-emulsified compositions esters with appropriate viscosity (see column 8, lines 14-33). van Hoorn is silent with regard to the viscosity of the esters used. When combining the teachings of van Hoorn and Nielsen, a person of ordinary skill in the art would have been motivated to use an ester with properties adapted to a non-emulsified composition, i.e.

low viscosity, and not esters that would resist the alkaline medium present in emulsified compositions. As such, a person of ordinary skill in the art would have used esters of mono- or dihydric alcohols suggested in Nielsen. The composition thus obtained, however, does not meet the limitations set forth in the claims.

Nielsen thus teaches away from the claimed invention, which requires the use of a composition comprising an ester of neopentyl polyol having at least 3 hydroxyl groups.

For the foregoing reasons, Applicant respectfully asserts that the combination of van Hoorn and Nielsen do not provide support for any of the rejections under 35 USC § 103. Since van Hoorn and Nielsen do not provide support for any of the rejections all 3 of the rejections under 35 USC § 103 must fail even though additional references are added. The failure of the van Hoorn and Nielsen references to provide primary support for the rejections results in the failure of a prima facie case of obviousness being made based on these references.

With the foregoing in mind, Applicant respectfully requests the Examiner withdraw all rejections under 35 USC § 103 which rely on the combination of van Hoorn and Nielsen, either alone or in combination with Erilli or Feustel.

Additionally, the Erilli and Feustel references are not analogous art and should be withdrawn from supporting any rejections under 35 USC § 103. As noted above, the fact that these references were asserted do not provide any additional support for the rejections under 35 USC § 103 which are primarily dependent upon the combination of van Hoorn and Nielsen. However, it should be noted that these additional references are not analogous art and should be withdrawn.

As set forth in the MPEP,

“[...] a reference in a field different from that of applicant’s endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his or her invention as a whole.” (MPEP 2141.01(a), emphasis added.)

Also, as indicated in the dictionary the term “removal” means either to take something away from one place or to another place or to make it disappear. In contrast, the dictionary definition of the term release relates to setting it free, to loosen or let it move, work or function.

Applicant respectfully asserts that Erilli and Feustel both pertain to different technical fields. In this regard, they both pertain to detergents and inks. The Examiner is in error by relying on these references to reject the present application because these do not meet the analogous art requirements as set forth in the MPEP as noted above and they are not reasonably pertinent to the particular problem with which Applicant was concerned.

From the Examiner's view, the problem the Applicant was concerned about in the present application was a release composition. The Examiner views this as a problem similar to the problem the Erilli reference is drawn to, i.e. a removal composition.

The Erilli reference is concerned with the removal of soil, in particular grease, from surfaces and suggests adding terpene solvents to a detergent in order to confer fragrance, improve grease removal, and perfume components dissolution (see column 2, line 11 and column 4, line 40).

The "removal" of soil and components from surfaces using the *cleaning liquid* in Erilli is different than the "release" of a molded piece from a mold. The release of a piece from a mold is a different problem than using a substance as a "solvent" in a detergent. The addition of terpene in the process as set forth in the claims is used to lower viscosity without impairing biodegradability (see page 3, lines 16-18 of the specification). In contrast, Erilli uses the addition of terpene to provide a grease removing solvent.

The Examiner is similarly in error with regard to the Feustel reference. Feustel is not analogous art merely because it mentions the addition of a saturated fatty ester ink as a release agent. The problem of ink release is not reasonably pertinent to the problem of the present invention since releasing ink is significantly different from releasing a molded piece from a mold. Reference to Feustel in support of a rejection overreaches the reasonable scope, teachings, and interpretation of Feustel. Feustel deals with releasing ink. The release of an ink substance is significantly different than releasing a molded piece of plaster or concrete from the mold in which it formed. The process of the claimed invention as set forth in the original specification as filed and the present amended claims is a significantly different process than that in relation to ink. There is no suggestion, teaching or motivation which would even remotely hint to one of ordinary skill in the art to consider ink technology in association with the molding of components.

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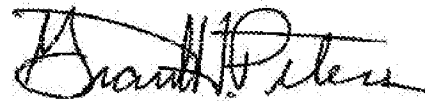
Based on the foregoing reasons, Applicant respectfully asserts that the Erilli and Feustel references are not analogous art and the rejection based on such assertion should be withdrawn.

If there is any issue remaining to be resolved, the Examiner is invited to telephone the undersigned so that resolution can be promptly affected.

It is requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response with the fee for such extensions and shortages in other fees, being charged, or any overpayment in fees being credited, to the account of Barnes & Thornburg LLP, Deposit Account No. 12-0913 (38624-100474).

Respectfully submitted,

BARNES & THORNBURG LLP



Grant H. Peters, Reg. No. 35,977
One of the Attorneys for Applicant

P.O. Box 2786
Chicago, Illinois 60690-2786

Phone: 312-357-1313
Facsimile: 312-759-5646

Customer No.: 23644